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09/747,614	12/21/2000	John D. Kleinke	20219-000300	1873

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EXAMINER
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BUI, KIM T

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 09/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/747,614

**Applicant(s)**

KLEINKE, JOHN D.

**Examiner**

Kim T. Bui

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12/21/2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 52,53 are objected to under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of the previous claim. Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form. It is unclear how the system of claims 52,53 further limit the method of claim 1. See MPEP § 608.01(n).

### ***Claim Rejections - 35 USC § 112***

2. Claims 40-51,54,55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) As per claims 40-49,51,54,55, the body of the claims fails to recite how the "securing" function in the preamble is accomplished.

(B) As per claim 50, the claim recite a method for appealing, however, there are no steps in the body of the claim to perform the appealing.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-39,50-51 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. The body of the claim(s) must recite how the technological art is employed to produce a useful, concrete and tangible result in a non-trivial manner.

(A) In the present case, claims 1-39, 50, 51 recite an abstract idea only. The recited steps of the claims are merely for determining a payer attribute and communicating across a network, and do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. The communication network, browser, Internet, server, medium, database interface, Internet page, radio button do not link to the determination of payer attributer are trivial and do not describe how the technological art is employed to produce a useful, concrete and tangible result in a non-trivial manner.

In addition, for a claimed invention to be statutory, it must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces a

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method for determining payer attribute (i.e., repeatable) used in medical treatment (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-39,50,51 deemed to be directed to non-statutory subject matter

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-10,15,17-19,22-27,31,34,35,38-40,42-44,46,50-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Provost et al (6341265).

(A) As per claim 1, Provost discloses a method for providing a payer attribute (i.e., forms, health, payment and claim data, decisions, statements, etc., ) from a system node (i.e. server) to a user node (i.e. client), the method comprising:

- a. receiving indicators (i.e. elements of an insurance claim form) from the user node (i.e., client) at the system node (i.e. server). Provost, the abstract, col. 7, lines 29-40, col. 8, lines 1-63, Figs 2,3, elements 26,32,36,46,etc...
- b. determining a payer attribute based on the indicators of the claim form. Provost, col. 6, lines 12-15, col. 10, lines 53-63.

c. communicating the payer attribute to user node across a computer network.

Provost, col. 6, lines 12-15, col.7, lines 60-68, col.10. lines 53-63.

(B) As per claims 2, 4, 5-7, Provost teaches that the indicators identify patient data, treatment code, insurance plan information, etc... Provost, Figs 2,3, elements 46,26,32,36, col. 8, lines 43-55, col. 9, lines 44-55. The treatment includes procedure, medication (i.e. pharmacological therapy etc..). Provost, col. 9, lines 44-55.

(C ) As per claims 3, 8, Provost teaches the payer attribute includes health care services (diagnosis codes and treatment codes) that are approved or denied. Provost, col. 6, lines 8-11, col. 10, lines 53-60.

(D) As per claims 9, 17, 27, 35, Provost teaches that client and server is communicated over the Internet, and HTML document can be transmitted to the use from the server via the Internet. Provost, col. 8, lines 1-15, lines 25-33, Figs 2.3.

(E) As per claims 10, Provost teaches the payer attribute includes criteria for meeting requirement, such as, validity or accuracy. Provost, col. 4, lines 7-21, col. 10, lines 53-63.

(F) As per claim 15, Provost teaches the user node (i.e. client computer) is located at the health care provider office. Provost, col. 6, line 65 to col. 7, line 5.

(G) As per claims 18,19, Provost teaches the a computer readable medium for storing instructions and structured data. Provost, col. 6, lines 30-68, the payer attribute includes combination of payer identifier and data, treatment identifier and data. Provost, Figs 2, 3, elements 32, 46, col. 7, line 40 to col. 9, line 65.

(H) As per claims 22,24,25, Provost teach the indicators of the claim form include patient, treatment (i.e. procedure), insurance plan, etc... Provost, col. 8, lines 43-55, col. 9, lines 44-55, Figs 2, 3, elements 26,32,46.

(I) As per claim 23, the user node (i.e. client computer) and the system node (i.e. server) include separate database systems for storing and communicating the indicators. Provost, col. 8, lines 22-33, col. 9, line 65 to col. 10, line 2.

(J) As per claim 26, Provost teaches the display for displaying the indicators of the claim form that are to be entered at the client computer using input means (i.e. mouse, keyboard). Provost, Figs 2, 3, col. 7, lines 20-25, col. 8, lines 20-65.

(K) As per claim 31, Provost teaches the steps for providing amended insurance claim (i.e., second interface) displayed at the client computer, and for communicating the amended claim to the server (i.e. payer). Provost, col. 11, lines 1-20.

(L) As per claims 34, 38, 39, Provost teaches the client receives responses from the server in response to the interfaces, as many times as desired. The responses include denial of the request, in response to the denial, amended form is created for appeal. Provost, col. 11, lines 1-20.

(M) As per claim 40, Provost et al. discloses a method for securing approval for medical treatment comprising:

- a. providing a system node (i.e. server) in communication with the Internet. Provost et al., col. 3, lines 40-43, col. 7, lines 29-40, lines 60-67;
- b. receiving at the system node indicators identifying medication and payer (i.e. health care services data and insurance plan data). Provost et al., col. 7, lines 29-51;

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c. providing at a user node across the Internet an interface for creating request for approval corresponding to medication and payer. Provost et al., col. 8, lines 16-33, col. 7, lines 20-27, lines 60- 67.

(N) As per claims 42, 46, Provost teaches different formats of interactive claims (i.e. requests and appeal requests), HTML documents via the Internet, and other formats. Provost, col. 8, lines 25-29, col. 2, lines 16-18, Figs 2,3.

(O ) As per claims 43, Provost teaches the steps for receiving a created request for approval from a user node and communicating the created request to the payer. Provost, the abstract, col. 8, lines 15-21, col. 8, line 33 to col. 9, line 14.

(P) As per claim 44, Provost teaches the steps for receiving a denial of the created request for approval of payment for treatment, and for proving user an appeal request (i.e. resubmitted request) corresponding to the denial. Provost, col. 10, line 53 to col. 11, line 20, col. 6, lines 12-21.

(Q) As per claim 50, Provost teaches a method for appealing a denial of medical treatment by a payer to secure approval for the medical treatment comprising:

a. receiving a denial of a request to approve a medical treatment. Provost, col. 10, line 53 to col. 11, line 20, col. 6, lines 12-21.

b. providing to a user across the Internet an appeal request corresponding to the denial of the request to approve. Provost, col. 10, line 53 to col. 11, line 20, col. 6, lines 12-21, col. 6 lines 54-56.

(R) As per claim 51, Provost discloses a method for securing approval for a particular medical treatment from a payer, comprising:



a. operating a user node to provide indicators to a system node wherein the system node associated with a database. Provost, col. 7, lines 20-51, col. 8, lines 15-21, elements 45,26,32,36 of Figs 2,3, the database comprising:

a payer (i.e., patient eligibility and insurance plan data) and an attribute (i.e. medical practice, medical procedure data) associated with the payer . Provost, col. 7, lines 40-52;

b. receiving the attributes (i.e. medical procedure, payment, insurance data) from the server node; Provost, col. 9, line 58 to col. 10, line 16;

c. receiving a customizable request for approval corresponding to the attribute. Provost, col. 9, col.9, lines 58 to col. 10, line 16, col.9, lines 30-36.

(S) As per claim 52, Provost teaches the server computer operable to perform the transmitting, receiving, retrieving, evaluating, approving or denying the insurance claim. Provost, Fig. 1, col.3, line 40 to col. 4, line 52, col. 7, lines 29-60.

(T) As per claim 53, computer executable instruction (i.e. software) is disclosed in col. 6, lines 30-35 of Provost.

(U) As per claim 54, Provost discloses a system for securing approval for medical treatment from a payer comprising:

a. a system node in communication with the Internet, wherein the system node associated with a computer readable medium. Provost, col. 3, lines 40-5, col. 6, lines 29-62;

b. the computer readable medium embodying an interactive request for approval of a medical treatment, Provost, col. 6, lines 26-62, col. 8, lines 15-33.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 14,16,20,32,33,41,45,47-49,55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Provost in view of Joao (6283761).

(A) As per claims 14, 16, Provost teaches that the client computer is operated by the medical practitioner on behalf of the patient, and can be located at any location of any person whose services can be compensated by a health insurer, as such, it is logical to include a client computer at a pharmacy. Furthermore, Joao teaches a healthcare information system for submitting claim including patient computer, Joao, col. 3, lines 17-25, and that the system can be utilized in different environments such as drug, medication. Joao, col. 4, lines 59-66. It would have been obvious to the one having ordinary skill in the art at the time of the invention to include patient computer and pharmacy with the motivation of providing variety of applications and services. Joao, col. 2, lines 30-45.

(B) As per claim 20, Provost fails to recite statistical data. This, however, is disclosed in Joao. Joao teaches statistical information associated with treatment, claim approval, and any other information. Joao, col. 17, lines 39-42, col. 18, lines 9-20, col. 19, lines 20-30.

(C) As per claims 32,33,41,45,55, Provosts teaches the interactive interfaces which can be HTML documents transmitted over the Internet or can be in other forms (i.e. electronic- mail), form with prepared header. Provost, col. 8, lines 25-29, col.2, lines 16-18, col. 9, lines 24-28, Figs 2,3. Furthermore, Joao teaches various forms of interfaces, such as, e-mail messages, electronic data transmission, physical mail delivery. Joao, col. 5, lines 10-18. It would have been obvious to the one having ordinary skill in the art at the time of the invention to include Internet page, e-mail, letter, claim form etc... with the motivation of providing variety of applications and services. Joao, col. 2, lines 30-45.

(D) As per claims 47-49, Provost fails to explicitly recite fax communication and electronic signature. This, however is well known as evidenced by Joao, Joao teaches a healthcare information system for submitting claim form including fax communication and electronic signature. Joao, col.18, lines 34-46. It would have been obvious to one having ordinary skill in the art at the time of the invention to include fax communication and electronic signature with the motivation of providing variety of applications and security technique. Joao, col.2, lines 29-35, col.4, lines 6-10.

9. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Provost in view of Mayaud (5845255).

(A) As per claims 11-13, Provost teaches alternative treatments, Provost, col.10, line 60 to col. 11, line 5, but fails to recite "the difference between treatments", "less optimal treatment". This, however, is well known, as evidenced by Mayaud. Mayaud discloses prescription management system having lists of drugs in categories and drug guidelines

displayed for first, second, third lines of therapy. Mayaud, col. 5, lines 32-43, col. line 65 to col. 6, line 2. It would have been obvious to one having ordinary skill in the art at the time of the invention to include differences between treatments with the motivation of providing references to the user for enhancing the selection of available products.

Mayaud, col. 5, lines 3-15.

10. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Provost in view of Peterson et al (6343271).

(A) As per claim 21, Provost fails to recite password. This, however, is well known as evidenced by Peterson et al. Peterson et al. teaches a claim processing system wherein password is provided to the user for accessing the system. Peterson et al. col. 14, lines 25-29. It would have been obvious to one having ordinary skill in the art at the time of the invention to include password with the motivation of increasing security.

11. Claims 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Provost in view of Colella et al. (6003006).

(A) As per claims 28-30, Provost suggests a broad range of users to include any person whose services can be compensated by a healthcare insurer and that the services can be of therapeutic supplies or devices. Provost, col. 7, lines 1-5, col. 9, lines 48-51. The steps for receiving, communicating, and ordering the medications are readily apparent. In addition, Colella et al. teaches a drug distribution system including the steps for receiving, ordering, and shipping the medication. Colella et al., col. 5, lines 33-60. It would have been obvious to one having ordinary skill in the art at the time of the invention to include drug ordering and shipping with the motivation of providing a

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complete health care management system for distributing the drug from warehouse to patient care area. Colella et al, col. 2, lines 45-52.

12. Claims 36, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Provost in view of Jacobs et al (6049794).

(A) As per claims 36,37, Provost teaches input means at the client node to enter data, but fails to explicitly recite the radio button. This, however, is well known as evidenced by Jacobs et al. Jacobs et al discloses a medical decision system having radio button. Jacobs et al., col. 10, lines 9-13. It would have been obvious to one having ordinary skill in the art at the time of the invention to include radio button as an input means with the motivation of easing the selection of input by the user.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. " Health Insurance Eligibility System" (5832447); " System For Review Of Medical Claims" (6324516); "Optimizing Medical Diagnosis, Procedures And Claims Using A Structured Search Space" (6393404); "System For Processing Health Care Transactions" (5930759); "Healthcare Payment Adjudication And Review System" (5359509); "Health Care For Comparing User Proposed And Recommended Resources" (5953704), "The revenue cycle from the patient's perspective: improve your revenue cycle by tailoring patient financial communications to meet patient needs", Rappuhn Terry Allison, Sept. 2003, Healthcare Financial Management, 57, 9, 64 (8), Dialog File 149, Acc. No. 02262225.

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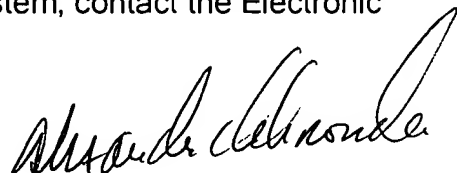
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim T. Bui whose telephone number is 703-305-5874. The examiner can normally be reached on Monday-Friday from 8:30A.M. to 5:00P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
KTB

9/16/04

  
ALEXANDER KALINOWSKI  
PRIMARY EXAMINER